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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,355	02/25/2004	Robert Linley Muir	FBR 21.015	4864
26304	7590	06/25/2004	EXAMINER	
KATTEN MUCHIN ZAVIS ROSENMAN 575 MADISON AVENUE NEW YORK, NY 10022-2585			HOTALING, JOHN M	
			ART UNIT	PAPER NUMBER
			3713	
DATE MAILED: 06/25/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/787,355	<b>Applicant(s)</b> MUIR, ROBERT LINLEY	
	<b>Examiner</b> John M Hotaling II	<b>Art Unit</b> 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/25/04</u> . | 6) <input type="checkbox"/> Other: _____  |

ELC

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berg et al US Patent 5,779,545 in view of Schneier et al US Patent 5,871,398. Berg discloses all of the instant application with respect to the transferring of game information over a network and the use of a random number determining a game output. However, Berg lacks in disclosing that the medium where the game information (random number seed) is transferred to is a smart card or a smart card chip. Instead, Berg discloses in column 3 that the general manner of constructing a program to control a microprocessor so as to permit a user to play various games and output results is well-known in the art. Further, motivation to provide other communication means can be found in column 3 lines 44-46 where the communications device 114 can be any of a plurality of devices known to those of skill in the art for receiving data communication and placing it in a format suitable for transmission to the microprocessor 108. In an analogous invention to Schneier a gaming machine that enables play of the machine on a remote computer by transferring authenticatable game authorization messages (AGAM) to the game machine. Schneier discloses in column 14 lines 12-33 the AGAM may be written to memory in the smart card, the player puts the smart card in the

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machine and the machine reads the message. Schneier also discloses other methods of transferring AGAM to the machine such as a modem. Both Schneier and Berg disclose throughout the references the different and varying uses of random number seeds and the various encryption decryption scenarios employed. Schneier discloses in column 15 the use of a seed value and a one way function which directs the HTV to generate corresponding outcomes/game authorizations using the one way function. The game authorization messages are authenticatable, and they are precluded from being used inadvertently or fraudulently, in the wrong HTV. An authentication/encryption module operating in accordance with the above, provides for authentication/encryption/decryption of messages to and from the HTV. It would be obvious to one of ordinary skill at the time of the invention to combine Berg and Schneier in order to have a distributed game system where the random number seeds could be securely transferred to a game machine on a smart card. The motivation to combine the references as stated by Berg that the communications device 114 could be any of a plurality of devices known to those of skill in the art for receiving data communication and placing it in a format suitable for transmission to the microprocessor 108, which is what the smart card of Schneier does.

***Citation of Pertinent Prior Art***

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cote et al '986, Kelley et al '740, Carlson '223 and '286, Zach '480, James '165 are all related to providing random number seeds to game machines for security and gaming purposes.

**Conclusion**

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Hotaling II whose telephone number is 703 305 0780. The examiner can normally be reached on Mon-Thurs 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703) 308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JOHN M. HOTALING, II  
PRIMARY EXAMINER

June 22, 2004

